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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,994	06/25/2001	Gianluca Girardi	210183US6X	7037

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EXAMINER

NGUYEN, TAM M

ART UNIT PAPER NUMBER

1764

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,994

Applicant(s)

GIRARDI ET AL.

Examiner

Tam M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 5, 2003 has been entered.

Response to Amendment

The rejection of claims 1-12 under 35 USC § 102(b) anticipated by Julian et al. (5,863,315) is withdrawn by the examiner in view of the amendment filed on August 5, 2003

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Julian et al. (5,863,315)

Julian discloses a process for separating of a hydrocarbon mixture (e.g., isopentane) by using an adsorption system which comprises at least three adsorption zones that function similar to the claimed process wherein the mixture of hydrocarbon isomers in gas phase is passed into a

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first adsorption zone to produce a first effluent which is then passed into a second adsorption zone. A mixture of desorbent remaining and isomers with a lower selectivity is discharged from at least one of the second adsorption zone. A desorbing agent is fed into at least one of the column functioning as the desorption zone to produce a mixture of desorbing agent and hydrocarbon isomers with a greater selectivity. The columns are then rotated as from the second adsorption zone to the first adsorption zone and to the desorption zone as claimed. The adsorption zone is operated at a temperature of from 100 to 400° C and at a pressure of from 5 to 40 bars and the desorbent is an aliphatic hydrocarbon which is in vapor phase. (See col. 3, line 15 through col. 7, line 45; figures 1-9 and 13-21)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julian et al. (5,863,315) in view of Kulprathipanja (5,900,523)

The process of Julian is as discussed above.

Julian does not specifically disclose steps of recovery desorbent from the raffinate and extract streams and recycling the desorbent for reuse. However, Kulprathipanja discloses steps of recovery desorbent from the raffinate and extract streams by using a distillation process (see col. 7, line 55 through col. 8, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Julian by separating desorbent from the raffinate and extract streams for reuse as taught by Kulprathipanja because such step is effective to recover desorbent for reuse.

Response to Arguments

The argument Jullian does not teach feeding an entire effluent of the mixtures of hydrocarbon isomers from at least one of the columns functioning as the primary adsorption device to at least one of the columns functioning as the secondary adsorption device is not

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persuasive because Jullian teaches that the entire or partial effluent from the first adsorption zone is fed into the second adsorption zone as claimed. (See figures 1, 4, and 7)

The argument that the desorbent is fed only to three phases out of the nine phases, the extract stream is present only in three phases, and only three out of the nine phases is not persuasive because the desorbent of Jullian is fed into the adsorption zones as claimed in claimed in claims 1 and 6.

The argument that Jullian process include first pressuring, depressurizing, and second pressurizing phases, while the process of claim 1 does not use the pressure changes for adsorption and desorption is noted. However, the argument is not persuasive because the claimed process does not exclude the pressure changes in the adsorption and desorption steps.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tam M. Nguyen
Examiner
Art Unit 1764


TN